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Jacques Fieschi

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EXAMINER

WORJLOH, JALATEE

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/810,286

Applicant(s)

FIESCHI ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-25 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-9-05.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is responsive to the amendment filed on February 18, 2005, in which claims 1,3,5 and 6 were amended and claims 21-25 added.

### ***Response to Arguments***

2. Applicant's arguments filed February 18, 2005 have been fully considered but they are not persuasive.

Applicants argue that Linehan fails to disclose the PIN codes of the present invention are not secret.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., PIN codes are not secret) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further, the examiner notes that the claim invention merely claims a PIN code, but does not explicitly distinguish this code from the conventional PIN codes. Applicants assert that the code is not a secret code, but instead a code that the seller knows. This alleged unique feature is not clearly expressed in the claims or the specification. Thus, “One purpose for examining the specification is to determine if the patentee has limited the scope of the claims.’ ... For example, an inventor may choose to be his own lexicographer if he defines the specific terms used to describe the invention ‘with reasonable clarity, deliberateness, and precision.’ Such a definitions

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may appear in the written description,..." *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002) (citations omitted). The meaning of Applicants' PIN code is not defined "with reasonable clarity, deliberateness, and precision."

As for the argument where Applicants indicate that the claimed invention requires only one card number for all the members of a group, such limitation is not expressed in the specification or the claims.

As for the argument where Applicants state that the invention allows the owner of a debit/credit card to limit their or another person's transaction to a given amount, this feature is incorporated in the newly added claim 25 and is not provided in the specification.

Additionally, Applicants' argue that Lee fails to disclose a second checking of the PIN code. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants' argues that Gifford fails to disclose authentication information for a sale by an electronic transaction when the pre-validation and validation provide authentication. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As per claim 5, Applicants amended claim 5 to recite "each PIN code authorizing a different maximum amount". This feature is old and well known in the art; Applicant is directed

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to col. 6, lines 6-47 of US Patent No. 5953710 to Fleming, in which such feature is clearly taught. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan, Lee in view of Hopkins to include the step wherein each Pin code authorizing a different maximum amount. One of ordinary skill in the art would have been motivated to do this because it allows “a limit to be set on the number of expenditures that can be made and allows the available credit to be determined by someone other than the card issuer. The method and system can be used to provide a mechanism for supervising credit or debit card usage.” (see Fleming col. 3, lines 5-10).

3. Claims 1-25 have been examined.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide support for the newly added detail, “wherein a member of the

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group limits a transaction involving the credit/debit card to a pre-determined purchasing amount”.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6327578 to Linehan in view of US Patent No. 6748367 to Lee.

Linehan discloses registering a purchase of at least one article by a buyer using a credit/debit card associated with at least one PIN code at a seller terminal connected to an electronic payment center (i.e. “issuer gateway”) by a communication network (see col. 7, lines 39-42 and 55-66), checking, by the electronic payment center, that the at least one PIN code which is provided by said buyer to said electronic payment center is associated with the number of said credit/debit card provided by said buyer to said seller terminal (see col. 8, lines 55-57). Linehan does not expressly disclose checking, by said electronic payment center, with a third party whether or not the said at least one PIN code is valid. Lee discloses checking, by said electronic payment center, with a third party whether or not the said at least one PIN code is valid (see col. 11, lines 18-23). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the step of checking, by said electronic payment center, with a third party whether or not the said at

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least one PIN code is valid. One of ordinary skill in the art would have been motivated to do this because it provides additional security, consequently minimizing fraud.

Referring to claim 2, Linehan discloses the buyer has a terminal (i.e. "consumer computer"), which is connected to a communication network and said terminal is configured to transmit the credit/debit card (i.e. "consumer identity and authentication information"), see col. 4, lines 19-24 and col. 7, lines 39-42.

Referring to claim 3, Linehan discloses the credit/debit card number and PIN code which has been provided to said seller terminal by said buyer is transmitted to said electronic payment center to check whether the PIN is associated with said credit/debit card number (see claim 1 above).

Referring to claim 8, Linehan and Lee disclose a system for validating an electronic payment by a credit/debit card comprising means adapted for carrying out the steps of the method according to claims 1 or 2 (see claim 1 above).

Referring to claim 9, Linehan discloses receiving transaction information from a buyer and a seller by an electronic payment center, performing a first validation with the transaction information from the buyer and seller by the electronic payment center and processing the sale by an electronic transaction upon authentication by the first validation (see col. 7, lines 39-42, 55-67; col. 8, lines 1-15, 55-57). Linehan does not expressly disclose requesting, by the electronic payment center, further validation from a third party to provide authentication by an electronic transaction and processing the sale by an electronic transaction upon authentication by the further validation. Lee discloses requesting, by the electronic payment center, further validation from a third party to provide authentication by an electronic transaction and processing the sale

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by an electronic transaction upon authentication by the further validation (see col. 11, lines 18-23). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include requesting, by the electronic payment center, further validation from a third party to provide authentication by an electronic transaction and processing the sale by an electronic transaction upon authentication by the further validation. One of ordinary skill in the art would have been motivated to do this because provides additional security, thereby reducing fraud.

Referring to claims 10 and 11, Linehan discloses the transaction information sent by the buyer is at least one article information, date and time of purchase, buyer PIN code, and credit/debit card number and the transaction information sent by the seller is at least one article information, date and time of purchase, and PIN code; wherein the article information includes purchase price (see col. 4, lines 10-17).

8. Claims 4,5,13, 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan and Lee as applied to claims 1 and 9 above, and further in view of US Patent No. 5999624 to Hopkins.

Linehan discloses electronic payment center (see claim 1 above). Linehan does not expressly disclose the payment center checks in at least one profile table whether said PIN code is associated with the credit/debit card number. Hopkins discloses the payment center checks in at least one profile table whether said PIN code is associated with the credit/debit card number (see col. 9, lines 58-62). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the step wherein the electronic payment center checks in at least one profile table whether said PIN code



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is associated with the credit/debit card number. One of ordinary skill in the art would have been motivated to do this because verifies the user's identity, thereby minimizing fraud.

Referring to claim 5, Linehan discloses checking by said electronic payment center whether the amount of said purchase of the at least one article is below a maximum amount authorized for the at least one PIN code (see col. 4, lines 28 & 29).

Referring to claims 13 and 14, Linehan discloses electronic payment center (see claim 1 above). Linehan does not expressly disclose the payment center comparing at least one portion of the transaction information with profile table information. Hopkins discloses the payment center comparing at least one portion of the transaction information with profile table information; wherein the profile table information comprises at least one of a credit/debit card number a buyer PIN code, and an authorization amount corresponding to the buyer Pin code (see col. 9, lines 58-62). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the step wherein the payment center compares at least one portion of the transaction information with profile table information. One of ordinary skill in the art would have been motivated to do this because it verifies the user's identity, thereby minimizing fraud.

Referring 20, Linehan discloses the payment center verifying the consumer's account has sufficient funds (see col. 4, lines 28-30). Linehan does not expressly disclose sending an error message to the buyer if the amount is outside an authorized limit. Hopkins discloses sending an error message to the buyer if the amount is outside an authorized limit (see col.9, lines 58-67; col. 10, lines 1-4). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the step of sending

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an error message to the buyer if the amount is outside an authorized limit. One of ordinary skill in the art would have been motivated to do this because it provides excellent customer service by notifying the consumer.

9. Claims 6,7,15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan, Lee and Hopkins as applied to claim 5 above, and further in view of US Patent No. 6205437 to Gifford.

Referring to claims 6 and 7, Linehan discloses electronic payment center (see claim 5 above). Linehan does not expressly disclose checking by said electronic payment center whether or not there is a prevalidation of the purchase of the at least one article by the buyer. Gifford discloses checking by said electronic payment center whether or not there is a prevalidation of the purchase of the at least one article by the buyer (see col.7, lines 40-61), wherein said prevalidation of the purchase of the at least one article by said buyer is cleared after it has been used (see col. 8, lines 51-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the step of checking by said electronic payment center whether or not there is a prevalidation of the purchase of the at least one article by the buyer. One of ordinary skill in the art would have been motivated to do this because it eliminates duplicate charges to the consumer account.

Referring to claim 15, Linehan discloses electronic payment center (see claim 9 above). Linehan does not expressly disclose the electronic payment center clears the one portion of transaction information form the third party. Gifford discloses the electronic payment center clears the one portion of transaction information form the third party (see col. 7, lines 40-61). At

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the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to allow the payment center to clear the at least one portion of transaction information from the third party. One of ordinary skill in the art would have been motivated to do this because it eliminates duplicate charges to the consumer account.

Referring to claim 21, Linehan discloses an electronic payment center (see claim 6 above). Linehan does not expressly disclose the step wherein if there is a prevalidation of the purchase ordered by said buyer, bypassing the step of checking, by said electronic payment center, with a third party whether the at least one PIN code is valid; however, this is an inherent step. PIN codes are usually used to authorize a user's identity; thus, if the identity has been previously verified there is no need to further verify the user.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan and Lee as applied to claim 9 above, and further in view of Gifford.

Linehan disclose the seller receiving a start message (see col. 11 above). Linehan does not expressly disclose the start message includes a credit/debit card number, an article identification, a transaction time, a transaction date, and a buyer PIN code from the buyer. Gifford discloses receiving a credit/debit card number, an article identification, a transaction time, a transaction date, and a buyer PIN code from the buyer (i.e. "payment order"), see col. 6, lines 16-32. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify method disclose by Linehan to include a credit/debit card number, an article identification, a transaction time, a transaction date, and a buyer PIN code from the buyer. One of ordinary skill in the art would have been motivated to do this because it provides detail transaction information necessary for processing the transaction.

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11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan in view of Gifford.

Referring to claim 16, Linehan discloses receiving transaction information from a buyer and a seller by an electronic payment center, performing a validation with the transaction information from the buyer and seller by the electronic payment center and providing authentication for a sale by an electronic transaction when the validation provide authorization (see col. 7, lines 39-42,55-67; col. 8, lines 1-15,55-57). Linehan does not expressly disclose performing a pre-validation of buyer information with a third party and providing authentication for a sale by an electronic transaction when the prevalidation provide authorization. Gifford discloses performing a pre-validation of buyer information with a third party and providing authentication for a sale by an electronic transaction when the prevalidation provide authorization (see col. 7, lines 40-61). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the step of performing a pre-validation of buyer information with a third party and providing authentication for a sale by an electronic transaction when the prevalidation provide authorization. One of ordinary skill in the art would have been motivated to do this because provides additional security, thereby reducing fraud.

12. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan and Gifford as applied to claim 16 above, and further in view of Hopkins.

Linehan discloses determining by the electronic payment center, whether the amount charged to the credit card number is within an authorized limit (see col. 4, lines 28-30). Linehan does not expressly disclose determining, by the electronic payment center, whether the amount

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charged to the credit card number is within an authorized limit, if a PIN code of the transaction information is verified. Hopkins discloses determining, by the electronic payment center, whether the amount charged to the credit card number is within an authorized limit, if a PIN code of the transaction information is verified (see col. 9, lines 68-67). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the step of determining, by the electronic payment center, whether the amount charged to the credit card number is within an authorized limit, if a PIN code of the transaction information is verified. One of ordinary skill in the art would have been motivated to do this because it ensures that the merchant receives compensation for the service provided.

Referring to claim 18, Linehan discloses a payment center (see claim 17 above). Linehan does not expressly disclose checking for the prevalidation of the PIN code when the amount charged to the credit card number is within an authorized amount. Gifford discloses checking for the prevalidation of the PIN code when the amount charged to the credit card number is within an authorized amount (see col. 7, lines 40-61). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the step of checking for the prevalidation of the PIN code when the amount charged to the credit card number is within an authorized amount. One of ordinary skill in the art would have been motivated to do this because it reduces fraud by verifying the user's identity.

Referring to claim 19, Linehan discloses the payment center verifying the consumer's account has sufficient funds (see col. 4, lines 28-30). Linehan does not expressly disclose sending an error message to the buyer if the amount is outside an authorized limit. Hopkins

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discloses sending an error message to the buyer if the amount is outside an authorized limit (see col.9, lines 58-67; col. 10,lines 1-4). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the step of sending an error message to the buyer if the amount is outside an authorized limit. One of ordinary skill in the art would have been motivated to do this because it provides excellent customer service by notifying the consumer.

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan an lee as applied to claim 1 above, and further in view of US Patent No. 6014650 to Zampese.

Linehan discloses a method of validating an electronic payment by a credit/debit card in a transaction system (see claim 1). Linehan does not expressly disclose the method wherein each PIN code of the at least one PIN code is used only once and a different PIN code of the at least one PIN code is used for a later transaction. Zampese discloses the method wherein each PIN code of the at least one PIN code is used only once and a different PIN code of the at least one PIN code is used for a later transaction (see col. 2, lines 1-4). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the step wherein each PIN code of the at least one PIN code is used only once and a different PIN code of the at least one PIN code is used for a later transaction. One of ordinary skill in the art would have been motivated to do this because it provides additional security thereby reducing fraud.

14. Claims 23 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan and Lee and as applied to claim 1 above, and further in view of US Patent No. 6213391 to Lewis.

Linehan discloses a method of validating an electronic payment by a credit/debit card in a transaction system (see claim 1). Linehan does not expressly disclose the method wherein the at least one PIN code is associated with two or more members of a group and the group is associated with the number of the debit/credit card. Lewis discloses the method wherein the at least one PIN code is associated with two or more members of a group and the group is associated with the number of the debit/credit card, wherein the at least one Pin code is different for different members of the group, and wherein the at least one PIN code authorizes a different purchasing amount for the different members of the group (col. 5, line 40-col.6, line 59).

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is (571)272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

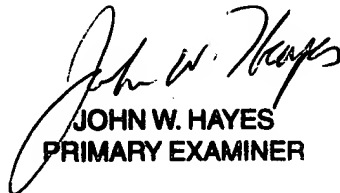
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571)272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jalatee Worjloh  
Patent Examiner  
Art Unit 3621

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April 28, 2005

  
JOHN W. HAYES  
PRIMARY EXAMINER